

REMARKS/ARGUMENTS

The present amendment is being filed under a Certificate of Mailing as indicated. An appropriate Petition for Extension of Time accompanies this Amendment and is also filed under a Certificate of Mailing.

Claims 1, 2, 4, 8-9, 14, and 25-27 were rejected under 35 USC §102(b) as being anticipated by French Patent 2,651,118 to Aubaniac.

Referring first to the rejection to claims 1, 2 and 4, claim 1 has been amended to provide "a centralizer defining an aperture therethrough for slidably receiving at least a portion of said rod, said rod and said centralizer closely conforming to each other during the slidable receiving thereof"

The element 3 of the prostheses of Aubaniac has a female taper in one end. The element 3 does not have "a centralizer defining an aperture therethrough" nor does the element 3 have "said rod and said centralizer closely conforming to each other during the slidable receiving thereof" as claimed in claim 1 of the present invention as now amended.

Claim 1, as amended, is thus, not anticipated by French Patent 2,651,118. The rejection to claim 1 as being anticipated by French Patent 2,651,118 is thereby believed to be overcome.

Claims 2 and 4 are dependent on newly amended claim 1, and are thus believed to be allowable over French Patent 2,651,118.

Reconsideration of the rejection under 35 USC §102b to claims 1, 2 and 4 as being anticipated by French Patent 2,651,118 is respectfully requested.

Referring now to the rejection to claims 8, 9 and 14, claim 8 has been amended to provide " a centralizer defining an opening therein, the opening of said centralizer and said rod having a closely conforming fit therebetween during the relative motion therebetween."

The element 3 of the prostheses of Aubaniac has a female taper in one end. The element 3 does not have "a centralizer defining an opening therein, the opening of said centralizer and said rod having a closely conforming fit therebetween during the relative motion therebetween" as claimed in claim 8 of the present invention as now amended.

Claim 8, as amended, is thus, not anticipated by French Patent 2,651,118. The rejection to claim 8 as being anticipated by French Patent 2,651,118 is thereby believed to be overcome.

Claims 9 and 14 are dependent on newly amended claim 8, and are thus believed to be allowable over French Patent 2,651,118.

Reconsideration of the rejection under 35 USC §102b to claims 8, 9 and 14 as being anticipated by French Patent 2,651,118 is respectfully requested.

Referring now to the rejection to claims 25-27, claim 25 has been amended to provide "placing a plug into the canal, the plug defining an opening therein," and "sliding the rod into the opening of the plug to centralize the stem, while maintaining intimate contact therebetween."

The element 3 of the prostheses of Aubaniac has a female taper in one end. The element 3 of the prostheses of Aubaniac does not provide for "sliding the rod into the opening of the plug to centralize the stem, while maintaining intimate contact therebetween" as claimed in claim 25 of the present invention as now amended.

Claim 25, as amended, is thus, not anticipated by French Patent 2,651,118. The rejection to claim 25 as being anticipated by French Patent 2,651,118 is thereby believed to be overcome.

Claims 26 and 27 are dependent on newly amended claim 25, and are thus believed to be allowable over French Patent 2,651,118.

Reconsideration of the rejection under 35 USC §102b to claims 25-27 as being anticipated by French Patent 2,651,118 is respectfully requested.

Claims 3, 7, 12 and 13 were rejected under 35 USC §103(a) as being unpatentable over French Patent 2,651,118 to Aubaniac in view of German Patent DE 3,314,210 to Otto.

The applicants have obtained an English translation of German Patent DE 3,314,210 to Otto, a copy of which is enclosed for the Examiner's reference.

Referring first to the rejection to claims 3 and 7, claim 1 has been amended to provide "a rod connected to said stem ... a centralizer defining an aperture therethrough for slidably receiving at least a portion of said rod, said rod and said centralizer closely conforming to each other during the slidable receiving thereof".

The element 3 of the prostheses of Aubaniac has a female taper in one end. The element 3 does not have "a centralizer defining an aperture therethrough" nor does the element 3 have "said rod and said centralizer closely conforming to each other during the slidable receiving thereof" as claimed in claim 1 of the present invention as now amended. The shaft 9 of the prosthesis of Otto is inserted into the cup of a cup like receptacle 1. The receptacle 1 of the prosthesis of Otto is not connected to the shaft 9, as claimed in claim 1, as amended. Neither Aubaniac or Otto either individually or in combination, teach or suggest such "a centralizer defining an aperture therethrough for slidably receiving at least a portion of said rod, said rod and said centralizer closely conforming to each other during the slidable receiving thereof" as claimed in claim 1, as now amended. The present invention provides for a centralization of the prosthesis in the canal while maintaining the plug in position in the canal during insertion. This advantage is not taught or suggested in the applied references.

Claims 3 and 7 which are dependent on newly amended claim 1, are thus, not obvious over French Patent 2,651,118 to Aubaniac in view of German Patent DE 3,314,210 to Otto and are thus believed to be allowable over French Patent 2,651,118 to Aubaniac in view of German Patent DE 3,314,210 to Otto.

Reconsideration of the rejection under 35 §103(a) to claims 3 and 7 as being unpatentable over French Patent 2,651,118 to Aubaniac in view of German Patent DE 3,314,210 to Otto is respectfully requested.

Referring now to the rejection to claims 12 and 13, claim 8 has been amended to provide "a rod connected to said stem ... and ...a centralizer defining an opening therein, the opening of said centralizer and said rod having a closely conforming fit therebetween during the relative motion therebetween".

The element 3 of the prostheses of Aubaniac has a female taper in one end. The element 3 does not have "the opening of said centralizer and said rod having a closely conforming fit therebetween" as claimed in claim 8 of the present invention as now amended. The shaft 9 of the prosthesis of Otto is inserted into the cup of a cup like receptacle 1. The receptacle 1 of the prosthesis of Otto is not connected to the shaft 9, as claimed in claim 1, as amended. Neither Aubaniac or Otto either individually or in combination, teach or suggest such "a rod connected to said stem ... and ...a centralizer defining an opening therein, the opening of said centralizer and said rod having a closely conforming fit therebetween during the relative motion therebetween" as claimed in claim 8, as now amended. The present invention provides for a centralization of the prosthesis in the canal while maintaining the plug in position in the canal during insertion. This advantage is not taught or suggested in the applied references.

Claims 12 and 13 which are dependent on newly amended claim 8, are thus, not obvious over French Patent 2,651,118 to

Aubaniac in view of German Patent DE 3,314,210 to Otto and are thus believed to be allowable over French Patent 2,651,118 to Aubaniac in view of German Patent DE 3,314,210 to Otto.

Reconsideration of the rejection under 35 §103(a) to claims 12 and 13 as being unpatentable over French Patent 2,651,118 to Aubaniac in view of German Patent DE 3,314,210 to Otto is respectfully requested.

Claims 5, 6, 10 and 11 were rejected under 35 USC §103(a) as being unpatentable over French Patent 2,651,118 to Aubaniac in view of European Patent EP 0006408 to Harder et al.

The applicants have obtained an English translation of European Patent EP 0006408 to Harder et al, a copy of which is enclosed for the Examiner's reference.

Referring first to the rejection to claims 5 and 6, claim 1 has been amended to provide "a rod connected to said stem ... a centralizer defining an aperture therethrough for slidably receiving at least a portion of said rod, said rod and said centralizer closely conforming to each other during the slidable receiving thereof".

The element 3 of the prostheses of Aubaniac has a female taper in one end. The element 3 does not have "a centralizer defining an aperture therethrough" nor does the element 3 have "said rod and said centralizer closely conforming to each other during the slidable receiving thereof" as claimed in claim 1 of the present invention as now amended. The plug of Harder is inserted into the medullary cavity. The plug includes a through hole 17 to compensate the pressure on insertion of the plug into the medullary cavity. The through hole 17 is preferably kept so narrow that bone cement can not pass through it in significant amounts. The plug of Harder does not have "a centralizer defining an aperture therethrough ... said rod and said centralizer closely conforming to each other during the slidable receiving thereof" as claimed in claim 1 of the present

invention as now amended. The plug of Harder is not designed to cooperate with a rod. In fact, the through hole 17 of the plug of Harder is preferably kept so narrow that bone cement can not pass through it in significant amounts. Neither Aubaniac or Harder either individually or in combination, teach or suggest such "a centralizer defining an aperture therethrough for slidably receiving at least a portion of said rod, said rod and said centralizer closely conforming to each other during the slidable receiving thereof" as claimed in claim 1, as now amended. The present invention provides for a centralization of the prosthesis in the canal while maintaining the plug in position in the canal during insertion. This advantage is not taught or suggested in the applied references.

Claims 5 and 6 which are dependent on newly amended claim 1, are thus, not obvious over French Patent 2,651,118 to Aubaniac in view of European Patent EP 0006408 to Harder et al. and are thus believed to be allowable over French Patent 2,651,118 to Aubaniac in view of European Patent EP 0006408 to Harder et al.

Reconsideration of the rejection under 35 §103(a) to claims 5 and 6 as being unpatentable over French Patent 2,651,118 to Aubaniac in view of European Patent EP 0006408 to Harder et al. is respectfully requested.

Referring now to the rejection to claims 10 and 11, claim 8 has been amended to provide "a rod connected to said stem ... and ...a centralizer defining an opening therein, the opening of said centralizer and said rod having a closely conforming fit therebetween during the relative motion therebetween".

The element 3 of the prostheses of Aubaniac has a female taper in one end. The element 3 does not have "a centralizer defining an aperture therethrough" nor does the element 3 have "the opening of said centralizer and said rod having a closely conforming fit therebetween" as claimed in claim 8 of the

present invention as now amended. The plug of Harder is inserted into the medullary cavity. The plug includes a through hole 17 to compensate the pressure on insertion of the plug into the medullary cavity. The through hole 17 is preferably kept so narrow that bone cement can not pass through it in significant amounts. The plug of Harder does not have "a centralizer defining an aperture therethrough ... said rod and said centralizer closely conforming to each other during the slidable receiving thereof" as claimed in claim 1 of the present invention as now amended. The plug of Harder is not designed to cooperate with a rod. In fact, the through hole 17 of the plug of Harder is preferably kept so narrow that bone cement can not pass through it in significant amounts. Neither Aubaniac or Harder either individually or in combination, teach or suggest such "a rod connected to said stem ... and ...a centralizer defining an opening therein, the opening of said centralizer and said rod having a closely conforming fit therebetween during the relative motion therebetween" as claimed in claim 8, as now amended. The present invention provides for a centralization of the prosthesis in the canal while maintaining the plug in position in the canal during insertion. This advantage is not taught or suggested in the applied references.

Claims 10 and 11 which are dependent on newly amended claim 8, are thus, not obvious over French Patent 2,651,118 to Aubaniac in view of in view of European Patent EP 0006408 to Harder et al. and are thus believed to be allowable over French Patent 2,651,118 to Aubaniac in view of in view of European Patent EP 0006408 to Harder et al.

Reconsideration of the rejection under 35 §103(a) to claims 10 and 11 as being unpatentable over French Patent 2,651,118 to Aubaniac in view of European Patent EP 0006408 to Harder et al. is respectfully requested.

The Federal Circuit has made it clear that a rejection under 35 U.S.C. § 103 is improper in the absence of a clear suggestion to combine the cited references. See, for example, *In re Dembiczak*, 50 USPQ 2d 1614, 1617-18, (Fed. Cir. 1999) wherein the Federal Circuit reversed a decision of the Board of Patent Appeals and Interferences rejecting as obvious claims to a plastic trash bag with a decorative pumpkin face: All the obviousness rejections affirmed by the Board resulted from a combination of prior art references, e.g., the conventional trash or yard bags, and the Holiday and Shapiro publications teaching the construction of decorated paper bags. [citation omitted] To justify this combination, the Board simply stated that 'the Holiday and Shapiro references would have suggested the application of ... facial indicia in the prior art trash bags.' [citation omitted] However, rather than pointing to specific information in Holiday or Shapiro that suggest the combination with the conventional bags, the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other and the conventional trash bags-described all of the limitations of the pending claims. [citation omitted] Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific-or even inferential- findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. [citation omitted]

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the



multiple prior art references can be combined to read on the claimed invention. ... Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. ... Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand.

The same analysis applies here. Since there is no discernable motivation for combining the Aubaniac and Otto references, the rejection of claims 3, 7, 12 and 13 under 35 U.S.C. § 103(a) cannot stand as a matter of law. Withdrawal of the rejection of claims 3, 7, 12 and 13 under 35 U.S.C. § 103(a) is respectfully requested.

A similarly broad conclusory statement was rejected by the Board of Patent Appeals and Interferences ("the Board") in the case entitled *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000). In that case, the examiner stated:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above references' teachings as taught by Sun et al., Lee et al., and Sandhu et al. because such use of planarized plugs by CMP [chemicalmechanical polishing] or etchback and the claimed deposition processes and materials are conventional and obvious as evidenced by Sun et al., Lee et al., and Sandhu et al. to enable the formation of a planarized plug for contact. In reversing the examiner's rejection of the pertinent claims, the Board, in *Ex Parte Huang*, No. 1997-3338, (Bd. Pat. App & Int. 1997), relied upon the decision of *In re Kotzab*, 217 F.3d

1365, 1369-70, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), which stated:

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

The Board then stated that "the examiner has not identified any motivation, suggestion or teaching of the desirability of combining Koyanagi or Scovell with Tsang, Shappir, Lee, Sun, and Sandhu to arrive at the appellants' claimed invention. Our reviewing court has made it clear that 'the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.'" Id. As a part of this requirement, the USPTO must provide particular findings as to the "identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis." See Dembiczak, 175 F.3d 994, 1000, 50 U.S.P.Q.2d 1614, 1617. Broad conclusory statements standing alone are not "evidence." Id. Based upon this ruling and the similarity of statements made by the examiner in Ex Parte Huang and the present case, the USPTO has clearly failed to meet its burden on showing the motivation to combine the references.

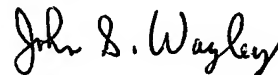
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Reply to Office action of March 29, 2004

The same analysis also applies here to the rejection of claims 5, 6, 10 and 11. Since there is no discernable motivation for combining the Aubaniac and Harder references, the rejection of claims 5, 6, 10 and 11 under 35 U.S.C. § 103(a) cannot stand as a matter of law. Withdrawal of the rejection of claims 5, 6, 10 and 11 under 35 U.S.C. § 103(a) is respectfully requested.

For the above-described reasons it is respectfully submitted that the rejections to the claims which have not been withdrawn or canceled, namely claims 1-14 and 25-27, have been overcome and that claims 1-14 and 25-27 are currently in condition for allowance. Early Notice of Allowance is respectfully requested.

Please feel free to contact John Wagley at 574-372-7332 if you have any questions.

Respectfully submitted,



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